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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,553	04/03/2006	Hidekuni Murakami	52433/838	2069
26646 7590 10/23/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER YEE, DEBORAH				
ART UNIT 1793		PAPER NUMBER		
MAIL DATE 10/23/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,553

Applicant(s)

MURAKAMI, HIDEKUNI

Examiner

Deborah Yee

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8500)
- Paper No(s)/Mail Date 4/3/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Claims 8 to 10 and 17 to 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 18, 2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 7 and 11 to 16 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Japanese patents 2000-239808 ("JP-808").
4. JP-808 discloses magnetic steel alloy examples 7, 9 to 12, 14 to 17, 19, 22, 24 and 25 in table 1 on page 5 which meet the claimed composition. In addition, the English abstract discloses steel containing finely dispersed Cu metal phase precipitate.
5. Even though JP-808 does not teach Cu-metal phase having a diameter $\leq 0.1\mu\text{m}$, a density $\geq 20\mu\text{m}^2$ and steel structure having an average grain size of 30-300 μm as recited by one or more of the dependent claims, such properties would be expected since composition is met and process of making is closely met and in absence of proof to the contrary. Note English abstract teaches steel alloy processed in substantially the same manner as Applicant comprising the steps of hot rolling and/or cold rolling

together with heating at 700-1050°C for ≥ 10 minutes (overlaps claimed range of 300 to 720°C for 5 seconds or more followed by holding in a temperature range over 800°C for 20 seconds or more) to precipitate second phases composed essentially of Cu in an amount ≥ 0.15 vol. %.

6. Claims 1 to 7 and 11 to 16 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Japanese patents 09-170053 ("JP-053").
7. JP-053 discloses steel alloy examples K-9-K-12 in table 1 on page 6 which meet the claimed composition. In addition, the English abstract discloses steel containing finely dispersed Cu metal phase precipitate at $\leq 0.1\mu\text{m}$, as evident by Figure 1.
8. Even though JP-053 does not teach Cu density $\geq 20\mu\text{m}^2$ and steel structure having an average grain size of 30-300 μm as recited by one or more of the dependent claims, such properties would be expected since composition is met and process of making is closely met and in absence of proof to the contrary. Note English abstract and paragraph [0012] teach steel alloy processed in substantially the same manner as Applicant comprising the steps of hot rolling, annealing, cold rolling and annealing followed by aging at 500-800°C together with heating at 700-1050°C for ≥ 10 minutes (overlaps claimed range of 300 to 720°C for 5 seconds or more followed by holding in a temperature range over 800°C for 20 seconds or more) to precipitate second phases composed essentially of Cu in an amount of ≥ 0.15 vol. %.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/
Primary Examiner
Art Unit 1793

/DY/